

**Notice of Allowability**

Application No.

09/927,597

Examiner

David J Steadman

Applicant(s)

MALIK ET AL.

Art Unit

1652

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendment filed 8/19/04.
2. ☒ The allowed claim(s) is/are 8 and 16-20.
3. ☒ The drawings filed on 10 August 2001 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All   b) ☐ Some\*   c) ☐ None   of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of the Application***

- [1] Claims 8 and 16-20 are pending in the application.
- [2] Applicants' amendment to the claims, filed August 19, 2004, is acknowledged. This listing of the claims replaces all prior versions and listings of the claims.
- [3] In a telephone conversation with applicants' representative, Mr. Scott L. Ausenhus, on or about September 02, 2004, Mr. Ausenhus informed the examiner that an information disclosure statement (IDS) for the instant application had been mailed. However, in another telephone conversation with Mr. Ausenhus on September 15, 2004, Mr. Ausenhus was informed that, as of drafting of the instant Office action, the IDS was not available for review by the examiner in the electronic application. As the six-month deadline for response is set to expire on September 19, it was agreed that in order to expedite prosecution and issue of the instant application, the instant Notice of Allowability would be mailed prior to consideration of the cited IDS reference(s).

### ***Claim Rejections - 35 USC § 112, First Paragraph***

- [4] In view of the amendment to the claims, filed August 19, 2004, the written description rejection and scope of enablement rejection of claims 8-9 under 35 U.S.C. 112, first paragraph, is withdrawn.
- [5] The claims are now limited to an isolated human smooth muscle myosin heavy chain polypeptide comprising SEQ ID NO:2, 6, 8, 10, 12, or 14 and having

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ATPase or actin binding activity. The rejections under 35 USC 112, first paragraph, have been withdrawn as the species encompassed by the genus are adequately described and it would not constitute undue experimentation to make and use the full scope of claimed polypeptides.

***Claim Rejections - 35 USC § 102***

**[6]** In view of the amendment to the claims, filed August 19, 2004, the rejection of claims 8-9 under 35 U.S.C. 102(a) as being anticipated by Database GenPept Accession Number P35749 and the rejection of claims 8-9 under 35 U.S.C. 102(b) as being anticipated by Database GenBank Accession Number AB020673 are withdrawn.

**[7]** The specification discloses that SEQ ID NO:6, 8, 10, 12, and 14 are subsequences of SEQ ID NO:2, with SEQ ID NO:6 being the smallest fragment of SEQ ID NO:2 (see pp. 7-8). Because SEQ ID NO:6 is a subsequence of SEQ ID NO:2, 8, 10, 12, and 14, if a polypeptide comprising SEQ ID NO:6 is free of the prior art, then it follows that a polypeptide comprising SEQ ID NO:2, 8, 10, 12, or 14 is also free of the prior art. A sequence alignment of Database GenPept Accession Number P35749 with SEQ ID NO:6 (Appendix A) or a sequence alignment of Database GenBank Accession Number AB020673 with SEQ ID NO:6 (Appendix B) shows that neither Database GenPept Accession Number P35749 nor Database GenBank Accession Number AB020673 is identical to SEQ ID NO:6.

***Reasons for Allowance***

**[8]** The following is an Examiner's statement of reasons for allowance. SEQ ID NO:6 is the smallest claimed fragment of SEQ ID NO:2 (see pp. 7-8) and because SEQ ID NO:6 is a subsequence of SEQ ID NO:2, 8, 10, 12, and 14, if a polypeptide comprising SEQ ID NO:6 is free of the prior art, then it follows that a polypeptide comprising SEQ ID NO:2, 8, 10, 12, or 14 is also free of the prior art. The examiner has found no teaching or suggestion in the prior art directed to a polypeptide having the amino acid sequence of SEQ ID NO:6. Therefore, claims 8 and 16-20, directed to an isolated polypeptide comprising SEQ ID NO:2, 6, 8, 10, 12, or 14, are allowable over the prior art of record. It is noted that the claimed polypeptides have at least one well-established utility that is specific, substantial, and credible as being used as affinity tags for purification of a fusion protein comprising the claimed protein. See for example, Manstein et al. (*J Mus Res Cell Mot* 16:325-332).

**[9]** Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

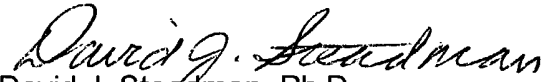
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (571) 272-0942. The Examiner can normally be reached Monday-Friday from 7:30 am to 4:00 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (571) 272-0928. Any inquiry of a general nature or relating to the

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status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

A handwritten signature in cursive script that reads "David J. Steadman".

David J. Steadman, Ph.D.

Primary Examiner

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09-15-04